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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/163,199	09/30/98	FUKUSHIMA	H 04783/026001

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601 13TH STREET NW  
WASHINGTON DC 20005

HM22/0620

EXAMINER

GARCIA, M

ART UNIT	PAPER NUMBER
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1627

DATE MAILED:

06/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/163,199

Applicant(s)

Fukushima et al

Examiner

Maurie E. Garcia, Ph. D.

Group Art Unit

1627

☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## DETAILED ACTION

**Please note:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1627**.

**Also Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 7, 8 and 18-20, drawn to a method of manufacturing a sensor device, classified in class 156, subclass 64.
  - II. Claims 5, 6, 9, 10 and 21-26, drawn to a method for evaluating the function of a substance, classified in various classes depending on the substance and the function, for example, 436, subclass 501 or 422, subclass 82.01.
  - III. Claims 11-17, drawn to a sensor device, classified in class 435, subclass 287.9.
2. The inventions are distinct, each from the other because of the following reasons:
3. Groups I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process

as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the sensor device could be made by other thin film printing methodologies (for example, micro-contact printing).

4. Groups III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, "evaluating the function of a substance" could be practiced with a variety of different sensor devices, for example, surface acoustic wave devices.

5. Groups I and II are different methods. The methods are different because they use different steps, require different reagents and will produce different products and/or results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, the method of manufacturing (Group I) is different from the methods of evaluating the function of a substance (Group II). Firstly, the methods require different reagents; Group I requires only the organic thin film, electrodes and transducing element while Group II requires a further substance to be sensed. Group II also requires the step of evaluation, which is not required in Group I. The methods also have completely different end results.

6. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different methods and products claimed would require completely different searches in the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

7. This application contains claims directed to patentably distinct species of the claimed invention. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species.

Species of thin film material

Species 1: Electro-conductive polymer	Claim 2
Species 2: Silicone-based surface modifying agent	Claims 3, 20
Species 3: Thiol	Claim 4

The species are distinct, each from the other, because their chemical structures and modes of action are different. They would also differ in their reactivity and the surface interaction. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

Claims 1, 7, 8, 18 and 19 are generic to this group.

8. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species.

Species of thin film material

Species 1: Electro-conductive polymer	Claim 12
Species 2: Silicone-based surface modifying agent	Claims 13, 14
Species 3: Thiol (requires gold thin film of claim 16)	Claims 15, 16

The species are distinct, each from the other, because their chemical structures and modes of action are different. They would also differ in their reactivity and the surface interaction. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

Claims 11 and 17 are generic to this group.

9. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

10. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

12. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

15. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
JYOTHSNA VENKAT, Ph.D.  
PRIMARY EXAMINER  
GROUP 1500  
SPE  
Art Unit 1627

Maurie E. Garcia, Ph.D.  
June 15, 2000





# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

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